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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,148	11/10/2003	John Werner Bulluck	TRIA:002D1	6075

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EXAMINER

SELLERS, ROBERT E

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 02/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/706,148	Applicant(s) BULLUCK ET AL.	
	Examiner Robert Sellers	Art Unit 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-87 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-87 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/10/2003</u> . | 6) <input type="checkbox"/> Other: ____. |

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-6 and 8-15, drawn to a two-part adhesive comprising (a) a monomer, a (hydro)peroxide and an antioxidant, and (b) a N,N-disubstituted aromatic amine, difunctional methacrylate and antioxidant, classified in class 252, subclass 183.11.

These claims were amended to limit the difunctional methacrylate to an alkylene glycol dimethacrylate in an amount of from 10 to 80 percent by weight and allowed in parent application no. 09/881,587 as U.S. Patent No. 6,734,249. The specification on page 1, line 6 should be amended to identify the status of the instant application as a divisional of application no. 09/881,587 filed June 14, 2001, U.S. Patent No. 6,734,249. The instant application would be more accurately designated as a divisional application if claims other than those of Group I are elected.

II. Claim 7, drawn to the two-part adhesive of Group I further comprising an acrylated polyester, γ -methacryloxypropyltrimethoxysilane or tris-(ω -methoxyethoxy)silane, classified in class 252, subclass 183.12.

III. Claims 16-23, drawn to the two-part adhesive of Group I wherein (b) contains an adhesion promotor and solvent instead of the difunctional methacrylate, classified in class 526, subclass 230.

IV. Claims 24-31, drawn to a two-part adhesive comprising (a) a monomer, a N,N-disubstituted aromatic amine and an antioxidant, and (b) a (hydro)peroxide and solvent, classified in class 524, subclass 559.

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V. Claims 32-48, drawn to a process for adhering two surfaces wherein primer Part B is applied to one surface, Part A is applied to the primed surface, and the other surface is pressed therewith, classified in class 156, subclass 280.

These claims have been prosecuted in application no. 10/706,882 which is a continuation of the same parent application no. 09/881,587 as that of the instant application.

VI. Claims 39-44 and 46-52, drawn to a process for adhering two surfaces, classified in class 156, subclass 306.3.

VII. Claim 45, drawn to the process for adhering two surfaces of Group V wherein Part A further contains an acrylated polyester, γ -methacryloxypropyltrimethoxysilane or tris-(ω -methoxyethoxy)silane, classified in class 156, subclass 326.

VIII. Claims 53-58 and 60-66, drawn to a process for setting an optical fiber within an optical fiber connector utilizing the two-part adhesive of Group I, classified in class 156, subclass 157.

IX. Claim 59, drawn to a process for setting an optical fiber within an optical fiber connector of Group VIII wherein Part A further contains an acrylated polyester, γ -methacryloxypropyltrimethoxysilane or tris-(ω -methoxyethoxy)silane, classified in class 156, subclass 158.

X. Claims 67-73, drawn to a process for setting an optical fiber within an optical fiber connector utilizing the two-part adhesive of Group III, classified in class 156, subclass 157.

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XI. Claims 74-80, drawn to a process for setting an optical fiber within an optical fiber connector employing the two-part adhesive of Group IV, classified in class 156, subclass 158.

XII. Claims 81-87, drawn to a process for setting an optical fiber within an optical fiber connector using the adhering process of Group V, classified in class 156, subclass 157.

The inventions are distinct from each other because:

2. Inventions I and II are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as a coating formulation and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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3. The adhesives of Group I or II, and Group III or IV are distinct because the adhesion promotor of Group III confers distinct structural and physical properties to the adhesive, and the presence of the N,N-disubstituted aromatic amine with the monomer in Part A of Group IV exhibits a materially different pot life.

4. Inventions (I-IV) and (V-XII) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product as claimed can be used in a materially different process of using that product such as the preparation of a molded article by combining and curing Part A and Part B.

5. Inventions V-VII directed to processes for adhering two substrates are distinct from Inventions VIII-XII denoting processes for setting an optical fiber within an optical fiber connector since the injection of the two-part adhesive into a ferrule and insertion of an optical fiber therein of Group VIII-XII constitutes a materially different manipulation.

6. The processes of adhering two substrates within Groups V-VII are different since the pretreatment of one surface with Part B as a primer required in Groups V and VII is a materially different manipulative step from the mere application of the mixture of Part A and Part B defined in Group VI. The presence of the additional reactive component in Part A of Group VII confers materially different properties from the two-part adhesive of Group VI.

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7. The process for setting an optical fiber within an optical fiber connector of Groups VIII-XII are distinct since diverse two-part adhesives containing different reactive constituents impart materially different characteristics to the fiber set with the cured adhesive.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

8. This application contains claims directed to the following patentably distinct species of the claimed invention:

1) The monomers of Part A such as the ethylene glycol dimethacrylate of the examples on page 13, lines 6-11.

2) The antioxidants such as the benzoquinone of the examples.

3) The N,N-disubstituted aromatic amines such as the N,N-dimethyl-p-toluidine of the examples.

4) The difunctional methacrylate monomers of Part B such as the ethylene glycol dimethacrylate alone, the ethoxylated bisphenol A diacrylate alone, or their mixture contingent upon the election of a Group containing this component.

5) The adhesion promoters wherein a species is identified contingent upon the election of Group III, V or X. There is no identification of any particular species of adhesion promoters in the specification.

6) The acrylated polyester, γ -methacryloxypropyltrimethoxysilane or tris-(ω -methoxyethoxy)silane contingent upon the election of Group II, VII or IX.

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Applicant is required under 35 U.S.C. 121 to elect a single disclosed species within items 1) to 4), and 5) and/or 6) if appropriate, for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-87 are generic.

A reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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The reply to this requirement to be complete must include an election of the invention and species to be examined even though the requirement is traversed (37 CFR 1.143).

Upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

9. The claims of Group I have been deemed to be allowable over the closest prior art of European Patent No. 96,500 and Japanese Patent No. 53-144760 due to the lack of recitation of the claimed amount of from 10 to 80 percent by weight of difunctional methacrylate monomer inserted by amendment. European Patent No. 452,540 discloses from 1-60% by weight of an alkanediol dimethacrylate (page 21, lines 15-16) functioning as a crosslinking monomer (page 2, lines 26-29). There is no motivation attributed to the disclosed level of alkanediol dimethacrylate sufficient to lead one skilled in the art to increase the exemplified proportion of European Patent No. 96,500 of about 2% by weight to within the claimed parameters.

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rs
2/14/05



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